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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,408	09/10/2001	Petrus Antonius Josephina Vos	VOS 2	3366

7590

08/14/2002

Browdy and Neimark  
624 Ninth Street N W  
Washington, DC 20001-5303

EXAMINER

SAKELARIS, SALLY A

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 08/14/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,408

Applicant(s)

VOS ET AL.

Examiner

Sally A Sakelarlis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 19-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed 7/26/02 have been fully considered but they are not persuasive. Applicant's election with traverse of Group II, claims 15-18 in paper No. 11 is acknowledged. The traversal is on the ground(s) that the examiner ignored the PCT rules for lack of unity of invention as unity was not broken in the international stage. However, it is maintained that although the examiner adhered to the PCT rules concerning the lack of unity of invention, they are not required to follow the precedent set forth during the application's international stage of prosecution. Each examiner adheres to the guidelines of the office and to his/her own discretion in their determination of the ability to, or to not, break unity in the national stage, 371 application. With respect to applicants contention that the special technical feature of the present claims is not anticipated by the Cantor et al. reference( US 6,007,987), the examiner points applicants attention to Table 1 of the present reference displaying the multiple restriction enzymes that can be used at both the 3' and 5' ends of the multiple probes comprising the arrays of this reference.

The lack of unity is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 15-18 are indefinite over the recitation of "corresponding to said AFLP-marker."

It is unclear as to how the "corresponding" should apply. It is unclear whether the restriction fragment sequence preceding, following, or within the AFLP marker is required to correspond to the AFLP-marker. It is further unclear what degree of similarity or concordance is implied in the phrase "corresponding" ie., how many base pairs of similarity or with what sequences that define an AFLP-marker. Applicant may wish to omit the phrase "corresponding" so that the claim reads only "comprises a restriction fragment sequence of said AFLP-marker."

B. Claims 16-18 are indefinite over the recitation of "optionally further amplifying, purifying and/or modifying the nucleic acid sequence; and" as it is unclear whether the following steps of d) and e) are optional also. It appears as though applicant may have intended step c) to be the only optional step but may wish to delete the "and" following step c) in order to further elucidate their intention.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by McCasky Feazel et al. (U.S. Patent No. 6,100,030).

McCasky Feazel et al. teach a method for providing an array of nucleic acid sequences bound to a carrier comprising the steps of using AFLP and PCR analysis to identify differentially amplified nucleic acids, providing these nucleic acid sequences as AFLP generated probes that map to polymorphisms(Col.3, lines 29-30). The reference also teaches attaching the nucleic acid probes to a solid support wherein the probe is a member of an array of probes(Col.53, lines 61-65). The reference further teaches that following AFLP analysis, but prior to attachment to the solid support, "individual bands that are unique to the population of interest (polymorphisms) ...are visualized...and are cut out of the gel"(Col. 9, lines 51-66). Following the extraction from the gel, the "DNA is amplified by placing the gel piece directly into a reaction vessel containing the PCR reagents and appropriate AFLP primers...PCR amplification of the DNA in the gel band"(Col. 10, lines 2-8) is then completed. The reference further teaches providing a nucleic acid sequence that comprises at least one restriction fragment "of DNA <that> is selected from the group consisting of cDNA, genomic DNA etc..."(Col. 54, lines 34-36). McCasky Feazel et al. anticipate claims 15-18 of the present application.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantai Dessau whose telephone number is (703)605-1237.

Sally Sakelaris

  
8/9/02

  
CECILIA TSANG  
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